

REMARKS

Claims 1-6 have been amended to remove reference to prodrugs and metabolites. Claims 7-9 have been withdrawn from consideration as being drawn to non-elected subject matter. Applicants reserve the right to pursue the subject matter of claims 7-9 in further divisional applications. Claims 1-6 are now pending for the Examiner's consideration.

For the reasons that follow, Applicants believe all claims are now in condition for allowance.

Restriction requirement under 35 U.S.C. § 121

Restriction requirement between the invention of group I, claims 1-6 (in part), and the invention of group II, claims 7-9 was set forth by the Examiner on pages 2-7 of the Office Action. Applicants confirm the election of the claims in group I. Non-elected claims of Group II have been withdrawn.

Rejection under et U.S.C. § 103

Claims 1-6 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Chu et al, U.S. Pat. No. 6,720,346, in view of Chong et al., U.S. Pat. No. 6,569,878. Applicants respectfully disagree.

The Examiner refers to MPEP 2142-2413 to assert that one of ordinary skill in the art would be guided by the teaching of Chu would, "be able to make similar compounds by replacing the carbonyl group in Chu with a sulphonyl group as taught in Chong. In addition, one skilled in the art would be able to make similar compounds by replacing the methyl group in Chong with a 2-(1-methylethoxy)ethyl group as taught in Chu. The motivation would be to prepare similar compounds pharmacologically active against cellular proliferative diseases and cancer." Such structural similarity does not establish a *per se* rule of obviousness. "[W]e have concluded that generalization should be avoided insofar as specific chemical structures are alleged to be *prima facie* obvious one from the other. . . . [T]here must be adequate support in the prior art for the . . . change in structure" *In re Grabiak*, 769 F.2d 729, 731, 226 USPQ 870, 872 (Fed. Cir. 1985). "[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed," *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). Applicants respectfully submit that the Examiner has failed to point to any motivation or suggestion in the prior art to replace the carbonyl with the elaborated sulfonyl and sulfonamide groups of the present invention. Chong provides either unsubstituted sulfonamide groups or sulfonamide groups that are only substituted with methyl. There is no suggestion in Chong or Chu to further modify the sulfonamide groups of Chong whatsoever. By contrast, the present invention is directed to sulfonyl and sulfonamide groups having at least one relatively bulky side chain (i.e. a sulfonamide of the present invention

would be substituted with a C₃₋₁₄ alkyl, 2-9 membered heteroalkyl, acyl, C₁₋₃ alkyl-nitrile, C₁₋₃ alkyl-carboxamide, C₁₋₄ alkyl-heterocycloalkyl, C₁₋₄ alkyl-aryl, C₁₋₄ alkyl-heteroaryl, C₃₋₁₀ cycloalkyl, 3-10 membered heterocycloalkyl, aryl or 3-10 membered heteroaryl . . .). The Examiner has not set forth a *prima facie* showing of a prior art combination having these specific limitations.

Rejection under 35 U.S.C. § 112

Claims 1-8 were rejected under 35 U.S.C. § 112, first paragraph for the reasons as set forth on pages 12-13 of the Office Action. Applicants believe that the current amendment to claims 1-6, has overcome the rejection of claims 1-6. Claims 7-8 have been withdrawn from consideration. Applicants submit that the claims are now in condition for allowance.


Conclusion

Applicants believe all claims are now in condition for allowance. Should there be any issues that have not been addressed to the Examiners satisfaction, Applicants invite the Examiner to contact the undersigned agent.

If any fees other than those submitted herewith are due in connection with this response, including the fee for any required extension of time (for which Applicants hereby petition), please charge such fees to Deposit Account No. 500329.

Respectfully submitted,

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